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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,879	04/20/2000	John Carnahan	47004.000056	5010

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HUNTON & WILLIAMS LLP  
 INTELLECTUAL PROPERTY DEPARTMENT  
 1900 K STREET, N.W.  
 SUITE 1200  
 WASHINGTON, DC 20006-1109

EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/552,879	<b>Applicant(s)</b> CARNAHAN ET AL.	
	<b>Examiner</b> Siegfried E. Chencinski	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 25, 2005 has been entered.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. **Claims 21-23, 27-30 and 34 are rejected** under 35 U.S.C. 102(e) as being anticipated by Wallman (US Patent 6,601,044 B1).

**Re. Claims 21 & 28**, Wallman anticipates a system and method for multivariable comparison of financial information, comprising:

- a) receiving weightable search information from a client interface, the weightable search information comprising user-selected quantitative search criteria and user-selected weighting criteria, the weighting criteria reflecting user-defined levels of importance for one or more of the quantitative search criteria (1. Interface - Abstract, II. 3-6, 10-015, Col. 13, II. 33-34, 41-43; Col. 23, II. 18-19. 2. weightable search information – (preferences – Col. 25, II. 22-25), Abstract, II. 6-8; weightable – Col. 20, I. 42; Col. 25, I. 56; Col. 26, I. 22; adjustable weighting - Col. 31, I. 23. 3. Quantitative criteria – Col. 23, II. 4-5; Col. 25, II. 52-54; Col. 26, II. 5-9); and
- b) accessing at least one network-enabled information source comprising financial information regarding a plurality of investment funds, each investment fund having

Art Unit: 3628

multiple quantitative investment fund variables associated therewith (network-enabled information - Fig. 1-6; Col. 23, ll. 36-43; funds – Col. 17, l. 51);

c) comparing the quantitative investment fund variables with the user-selected quantitative search criteria and the user-selected weighting criteria (Funds - Col. 17, ll. 18-27; weightable – Col. 20, l. 42; comparing to the criteria – Col. 24, ll. 10-12; Col. 26, ll. 5-9);

d) generating search results comprising.- a first set of investment funds that do not satisfy all of the user-selected quantitative search criteria, but which satisfy the overall user-defined criteria based on the combination of the user-selected weighting criteria and the user-selected quantitative criteria (Col. 17, l. 51; Col. 31, ll. 30-43.).

**Re. Claims 22 & 29**, Wallman anticipates a system and method wherein the one or more investment funds comprise one or more mutual funds (Col. 17, ll. 18-54). Wallman teaches that mutual funds are included in his broad definition of investment funds (Col. 17, ll. 21-24). Further, even though Wallman points out certain advantages to an investor's personal selection and maintenance of individual investments in a portfolio, he nevertheless states the ability of his system and method to include any kinds of investment funds in his system and method, such as those typically contained in an IRA or 401(k) account, as part of a comprehensive approach if an investor prefers to manage all of his investment holdings through Wallman's system (Col. 17, ll. 34-54).

**Re. Claims 23 & 30** Wallman anticipates a system and method further comprising a results interface operative to display the search results to the user (Fig's 5, 7, 8, 13, 15; Col. 32, ll. 29-40).

**Re. Claims 27 & 34**, Wallman anticipates a system and method wherein the search results further comprise a second set of search results comprising investment funds that satisfy all of the user-selected quantitative search criteria (Col. 33, ll. 33-36. It is inherent that the search results accepted by the investor meet all of his quantitative search criteria., and that this set of search results can reasonably be classified as a "second" set of search results.).

Art Unit: 3628

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claims 24 & 31 are rejected** under 35 U.S.C. 103(a) as being disclosed by Wallman in view of O'Shaughnessy (US Patent 6,317,726 B1).

**Re. Claims 24 & 31**, Wallman discloses a system and method wherein the results interface comprises a graphical user interface operative to display the one or more investment (Col. 13, 32-34; Col. 17, I. 51). Wallman does not explicitly disclose the display of the one or more investment funds in a sortable list. However, O'Shaughnessy discloses the display the one or more investment funds in a sortable list (Col. 18, II. 42-46, 50-62). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of the invention to have combined the art of Wallman with the art of O'Shaughnessy for the purpose of permitting the evaluation of search results in various sortable sequences in order to help reduce the complexity of the evaluation of investment information through a rule-based presentation available through automated sorting schemes to aid in investment decision making (O'Shaughnessy, Col. 1, II. 45-51).

**4. Claims 25, 26, 32 & 33 are rejected** under 35 U.S.C. 103(a) as being disclosed by Wallman in view of Hambrecht et al. (US Patent 6,629,082 B1, hereafter Hambrecht).

**Re. Claims 25, 26, 32 & 33**, as shown in the rejection of claims 22 and 29 above, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have seen Wallman's teaching as disclosing a system and method wherein the one or more investment funds comprise one or more mutual funds. Wallman explicitly discloses a results interface operative to receive requests for a prospectus or for an application for one or more of the one or more mutual funds. However, Hambrecht discloses a hot link to an investment prospectus and to an investment application for a

Art Unit: 3628

new issue of a financial security (Col. 9, ll. 7-17; Col. 10, l. 31 – Col. 11, l. 10). It would have been obvious to an ordinary practitioner of the art at the time of the invention to have adapted the hot links tool for ordering information to a web site offering information on financial investments, including for a prospectus or for an application for one or more of the one or more mutual funds. It would therefor have been obvious to the ordinary practitioner to combine the art of Wallman with the art of Hambrecht for the purpose of offering a hot link attached to a financial information search web site's results interface for receiving requests for investment information such as a prospectus of a financial investment, including a mutual fund, and for ordering an application to invest in one or more financial securities, including mutual funds. The motivation would have been to enhancing the ability of an investor to bid for securities on a more equal footing by being better informed (Hambrecht, Col. 1, ll. 48-51).

### ***Response to Arguments***

5. Applicant's arguments filed October 29, 2004 have been fully considered but they are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. **The prior art made of record and not relied upon** is considered pertinent to applicant's disclosure:

a) Herz, US Patent 6,029,195. Herz teaches "user-customized rank ordered listing of target objects most likely to be of interest to each user (Col. 5, ll. 16-17). Herz also teaches the application of his invention by investors targeting publicly traded stocks (Col. 9, ll. 61-62; Col. 12, ll. 38-60)

b) Chang, US Patent 5,321,833. Chang is referred to by Herz (Col. 4, ll. 13-17). Chang discusses weighting in the Background of his invention (Col. 1, ll. 38-40), and includes relative weighting in his invention (Col. 2, ll. 34-36).

c) Robert E. Cumby, Jack D. Glen; Evaluating the Performance of International Mutual Funds; Journal of Finance; Vol. 45, No. 2 Jun. 1990), pp. 497-521. This paper examines the performance of a sample of U.S.-based internationally diversified mutual funds between 1982 and 1988. One of the performance measures used is "the positive period weighting method proposed by Grinblatt and Titman" (Abstract).

Art Unit: 3628

d) Tim McLaughlin; Tapping Web to Search for Right Fund – FundProfiler Speeds Search; Boston Herald; Dec. 16, 1999; p. 70. FundProfiler allows investors to find, compare and invest in more than 5,500 funds online. After selecting a risk profile such as “moderately aggressive”, investors click on 11 separate investment criteria and weight them according to importance.

e) John Markese; Can You Trust Mutual Fund Rankings? Consumer Research; October 1993; pp. 20-24. Mr. Markese reviews the mutual fund ranking systems of 10 prominent periodicals, including the use of weightings.

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on (571) 272-6799.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks, Washington D.C. 20231*

or faxed to:

(703)872-9306 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Application/Control Number: 09/552,879

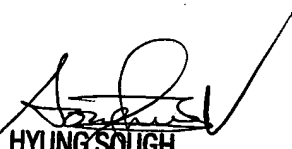
Page 7

Art Unit: 3628

Hand delivered responses should be brought to the address found on the above  
USPTO web site in Alexandria, VA.

SEC

June 22, 2005



HYUNG SOUH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600